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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/925,618	08/10/2001	Johannes Platzek	SCH-1774	2982

23599 7590 07/01/2003

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EXAMINER

HARTLEY, MICHAEL G

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 07/01/2003

6

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/925,618

Applicant(s)

PLATZEK ET AL.

Examiner

Michael G. Hartley

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 51-86 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 51-86 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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Response to Amendment

The amendment filed 5/12/2003 has been entered. Claims 1-50 have been canceled. New claims 51-86 have been added. Consequently, claims 1-86 are pending and have been examined herein. The substitute specification has been received and entered.

Response to Arguments

Any previous rejections that are not reiterated herein have been withdrawn.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 51-60, 82, 83 and 86 are rejected under 35 U.S.C. 103(a) as being unpatentable over Platzek, WO 97/26017 (US equivalent US 6,468,502, relied on for cited pertinent disclosures), for the reasons set forth in the office action mailed 2/12/2003.

Claims 51-56, 61-81, 84 and 85 are rejected under 35 U.S.C. 103(a) as being unpatentable over Platzek, WO 99/01161 (US equivalent US 6,019,595, relied on for cited pertinent disclosures), for the reasons set forth in the office action mailed 2/12/2003.

Response to Arguments

Applicant asserts that the Platzek references fail to teach a method wherein plaque or necrotic tissue is viewed directly, i.e., visualized.

This is not found persuasive because the Platzek references disclose methods of imaging vascular tissues and diseases thereof, ischemic tissues, infarctions, etc., as cited in the previous office action. The Platzek references teach that the complexes are extremely well suited for imaging the vascular diseases, since they disperse therein after administration. These are the same tissues which

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are claimed. The imaging would differentiate between the infarction and the vascular tissue, therefore would provide a visualization of the infarction, plaque or other presence of vascular disease. Since the Platzek references teach imaging such conditions, it is unclear how the instant claims are said to be different. The claims do not limit the methods to detect the accumulation of contrast agent in a specific tissue or condition (i.e., plaques, etc.), but only visualizing such conditions, which is disclosed by the Platzek references. The claims do not limit the tissue which is "lit up" by the contrast agent, either the plaque or the vascular tissue.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 51-56 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of copending Application No. 09/925,622, for the reasons set forth in the office action mailed 2/12/2003.

Claims 51-56 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of copending Application No. 09/925,420, for the reasons set forth in the office action mailed 2/12/2003.

These are a provisional obviousness-type double patenting rejections because the conflicting claims have not in fact been patented.

The amendment filed 5/12/2003 did not include a response or arguments to these double patenting rejections. Thus, they are maintained for reasons of record.

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Priority

Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Germany on 08/11/2000. It is noted, however, that applicant has not filed a certified copy of the 10040380.8 as required by 35 U.S.C. 119(b).

In the response filed 5/12/2003, applicant stated that a certified copy has been submitted. However, no certified copy is present in the case or attached to the amendment. Thus, the request for another certified copy of application 10040380.8, filed in Germany on 08/11/2000 is made herein.

Conclusion

No claims are allowed at this time.


THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael G. Hartley whose telephone number is (703) 308-4411. The examiner can normally be reached on M-F, 7:30-5, off alternative Mondays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page can be reached on (703) 308-2927. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4556 for regular communications and (703) 308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.


Michael G. Hartley
Primary Examiner
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MH
June 30, 2003